IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Masayuki NUMAO et al.   Examiner: MORSE, Gregory A.

Serial No: 10/600,547   Art Unit: 2134

Filed: June 20, 2003

For: INFORMATION DISTRIBUTION
AND PROCESSING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a notice of appeal and before filing of an appeal brief.

The review is requested for the reasons stated on the attached sheets totaling five (5) or fewer pages.

Respectfully submitted,

Dated: October 9, 2007   /ido tuchman/
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REASONS FOR REQUEST FOR REVIEW

<u>Claim 1</u>

Claim 1 recites, part in, "a user terminal for accessing said key management server to obtain attribute secret keys generated based on said secret keys, said attribute secret keys corresponding to attributes identifying said user terminal."

In rejecting claim 1, the Examiner acknowledges Matsumoto (U.S. Patent No. 6,215,877) fails to disclose this claim element, but alleges such teaching can be found in Lerner (U.S. Patent No. 6,169,802). FOA, pg. 3. Specifically, the Examiner points to column 6, lines 52-62 of Lerner. <u>Id.</u> The Examiner provides no explanation or reasoning for this conclusion.

It is well settled that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." <u>In re Kahn</u>, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336, quoted with approval in <u>KSR Int'l Co. v. Teleflex Inc.</u>, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

In rejecting claim 1, the Office Action merely cites column 6, lines 52-62 of Lerner without any reasons given. The rejection does not provide a comprehensive explanation of why the examiner considers the limitations of claim 1 disclosed in the prior art. The Lerner citation states,

> Creating the key based on a combination of both message data and other unique attributes relating to the messaging device is attractive because message data can often be identical. If the message data is identical, and the key is generated solely based on the message data, then the new private key may be identical to the previous one. However, if the messaging device or paging terminal finds that the new key is identical to the old key, the messaging device or terminal can manipulate the new key in a specified manner such that a unique key is generated each and every time. Lerner, col. 6, ln. 52-62.

It is apparent that the citation makes no mention of a user terminal for accessing a key management server to obtain attribute secret keys generated based on secret keys, with attribute secret keys corresponding to attributes identifying said user terminal. According to Lerner, private keys

are generated dynamically, based on the contents of a previously transmitted message. Lerner, col. 6, ln. 29-35.

Without a clear explanation in the Office Action of disclosed structures relied upon in the prior art, the Applicants are left guessing what the Examiner was thinking when making the rejection. Thus, the rejection of amounts to a conclusory statement unsupported by articulated reasoning or rational underpinning. See 37 CFR 1.104(c)(2).

For at least these reasons, claim 1 is believed allowable over the cited references. As such, the Appellants earnestly request reconsideration and allowance of claim 1.

<u>Claims 4, 6, 9, 20 and 21</u>

Claims 4, 6, 9, 20 and 21 were rejected for similar reasoning as claim 1. Thus, claims 4, 6, 9, 20 and 21 are believed allowable for at least the same reasons as claim 1.

<u>Claim 5</u>

Claim 5 recites, part in, "The server according to claim 4, wherein said attribute secret key generator generates said attribute secret keys by using a protocol implementing oblivious transfer protocol."

In rejecting claim 5, the Examiner argues that the oblivious transfer protocol is "Applicant Admittance Prior Art" and is therefore obvious to combine with Matsumoto and Lerner.

When there is no suggestion or teaching in the prior art, the suggestion cannot come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Under the Examiner's logic only inventions that utilize never-before seen items are patentable. The mere mentioning of an item's existence in a specification renders the item obvious to implement. The bar for obtaining a patent as not yet been set this high.

For at least this reason, claim 5 is believed allowable over the cited references. As such, the Appellants earnestly request reconsideration and allowance of claim 5.

Claim 19

Claim 19 was rejected for similar reasoning as claim 5. Thus, claim 19 is believed allowable for at least the same reasons as claim 5.

Claim 2

Claim 2 recites, "The information distribution system according to claim 1, wherein said provider terminal distributes said encrypted content without specifying an address of said user terminal that is to receive said encrypted content."

In rejecting claim 2, the Examiner acknowledges Matsumoto fails to disclose the subject matter of claim 2, but alleges such teaching can be found in Kawano (U.S. Patent No. 5,933,605). FOA, pg. 7. Specifically, the Examiner points to column 11, lines 40-57 of Lerner. Id. The Examiner provides no explanation or reasoning for this conclusion.

As mentioned above, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336, quoted with approval in KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

In rejecting claim 2, the Office Action merely cites column 11, lines 40-57 of Kawano without any reasons given. The rejection does not provide a comprehensive explanation of why the examiner considers the limitations of claim 1 disclosed in the prior art. The Kawano citation states,

> In the communication system using the contents code, the transmitting computer attaches to the transmission data the contents code corresponding to the contents of transmission data and then transmits the resultant data without recognizing the address of the party. A receiving computer sets data to be received on the basis of the contents code of the transmission data. Thus, the receiving computer can execute its operation without recognizing the position of itself and number of the computers as an transmission originator of the transmission data while taking only the data contents into consideration. Since each computer receives data while not specifying the data transmission

originator, it is only required to broadcast the transmission data within the system and for the receiving computer to receive the data alone attached to the coincidence contents code. As a result, the data receiving operation can be carried out independently of the expansion of the system such as addition or deletion of a transmitting computer. Kawano, col. 11, ln. 40-57.

It is apparent that the citation makes no mention of a provider terminal distributing encrypted content without specifying an address of a user terminal that is to receive the encrypted content. According to Kawano, a transmitting computer attaches to the transmission data the contents code corresponding to the contents of transmission data and then transmits the resultant data without <u>recognizing</u> the address of the party.

Without a clear explanation in the Office Action of disclosed structures relied upon in the prior art, the Applicants are left guessing what the Examiner was thinking when making the rejection. Thus, the rejection of amounts to a conclusory statement unsupported by articulated reasoning or rational underpinning. See 37 CFR 1.104(c)(2).

For at least these reasons, claim 2 is believed allowable over the cited references. As such, the Appellants earnestly request reconsideration and allowance of claim 2.